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EXAMINER

SHERR, CRISTINA O

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5 UNITED STATES PATENT AND TRADEMARK OFFICE
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8 BEFORE THE BOARD OF PATENT APPEALS
9 AND INTERFERENCES
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12 *Ex parte* DANIEL V. EAST and WILLIAM J. BENTLEY
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15 Appeal 2008-3066
16 Application 09/982,852
17 Technology Center 3600
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20 Decided: January 13, 2009
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23 Before HUBERT C. LORIN, ANTON W. FETTING, and JOSEPH A.
24 FISCHETTI, *Administrative Patent Judges*.
25 FETTING, *Administrative Patent Judge*.

26 DECISION ON APPEAL

27 STATEMENT OF THE CASE

28 Daniel V. East and William J. Bentley (Appellants) seek review under
29 35 U.S.C. § 134 of a final rejection of claims 1-4 and 7-24, which along with
30 allowed claims 5 and 6 are the only claims pending in the application on appeal.

31 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).
32

1 We REVERSE.

2 The Appellants invented a way of providing access to application software
3 in the event of inaccessibility of a license management system (Specification 3:2-
4 4).

5 An understanding of the invention can be derived from a reading of exemplary
6 claims 1 and 16, which are reproduced below [bracketed matter and some
7 paragraphing added].

8 1. A method for providing access to application software in the event
9 of inaccessibility of a license management system, comprising the
10 steps of:

11 [1] determining whether a user has a valid software license to run a
12 software application on a client workstation including sending a query
13 to the license management system; and

14 [2] permitting a recognized user to execute said software application
15 on said client workstation in the event that

16 the license management system is unable to receive and/or
17 respond to said query,

18 and/or is unable to communicate with said client workstation
19 about said query.

20
21 16. A system for managing access to concurrent software licenses,
22 comprising:

23 [1] a network;

24 [2] a license management system coupled to said network operative to
25 authorize a user of a software application; and

26 [3] a client workstation coupled to said network,

27 [4] wherein said client workstation comprises a validation
28 device operative to permit a recognized user to execute said
29 software application in the event that the license management

system is unable to communicate with said client workstation over said network.

This appeal arises from the Examiner's final Rejection, mailed May 4, 2006. The Appellants filed an Appeal Brief in support of the appeal on January 29, 2007. An Examiner's Answer to the Appeal Brief was mailed on June 11, 2007. A Reply Brief was filed on August 10, 2007.

PRIOR ART

The Examiner relies upon the following prior art:

Christiano	US 5,671,412	Sep. 23, 1997
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REJECTION

Claims 1-4 and 7-24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Christiano.

ISSUES

The issue pertinent to this appeal is whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-4 and 7-24 under 35 U.S.C. § 103(a) as unpatentable over Christiano.

The pertinent issue turns on whether Christiano’s system permits a recognized user to execute a software application if a license management system is unable to receive and/or respond to a query, and/or is unable to communicate with a client workstation about that query.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Claim Construction

01. The disclosure defines a recognized user as a user who has been previously authorized by the license management system as a valid user (Specification 14:4-5).

Christiano

02. Christiano is directed to a license management system suitable for licensing and managing the usage of software products (Christiano 1:4-6).

03. Christiano describes a fail safe indicator entered in the license record if the license item includes a fail safe indicator. The fail safe indicator allows licenses to be checked out when no licenses are available during failures, such as during license management system failures, when normally no licenses would be available. For example, whenever a failure occurs in a license management system, licenses are typically denied to new requesters. However, a software developer selling a product to a large, trusted company may wish to provide a more lenient policy which allows the customer to check out licenses when an error occurs in the license management system. In some embodiments, a fail safe license can be checked out regardless of the type of error. In other embodiments, the fail safe license can be checked out only when the error is an actual failure of the license system, and not when the client is

denied a license due to the license policy (i.e. "no licenses available") (Christiano 17:16-34).

Facts Related To Differences Between The Claimed Subject Matter And The Prior Art

04. Christiano does not describe having the capacity to recognize a user who has been previously authorized by the license management system as a valid user. The claim 1 subject matter requires this capacity in identifying its recognized user.

Facts Related To The Level Of Skill In The Art

05. Neither the Examiner nor the Appellants has addressed the level of ordinary skill in the pertinent arts of systems analysis and programming, software licensing systems, and data communication systems. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Facts Related To Secondary Considerations

06. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

1 During examination of a patent application, pending claims are given
2 their broadest reasonable construction consistent with the specification. *In*
3 *re Prater* , 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci.*
4 *Tech Ctr.*, 367 F.3d 1359, 1364, (Fed. Cir. 2004).

5 Limitations appearing in the Specification but not recited in the claim are not
6 read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed.
7 Cir. 2003) (claims must be interpreted “in view of the specification” without
8 importing limitations from the specification into the claims unnecessarily)

9 Although a patent applicant is entitled to be his or her own lexicographer of
10 patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*,
11 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such
12 definitions in the Specification with sufficient clarity to provide a person of
13 ordinary skill in the art with clear and precise notice of the meaning that is to be
14 construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although
15 an inventor is free to define the specific terms used to describe the invention, this
16 must be done with reasonable clarity, deliberateness, and precision; where an
17 inventor chooses to give terms uncommon meanings, the inventor must set out any
18 uncommon definition in some manner within the patent disclosure so as to give
19 one of ordinary skill in the art notice of the change).

20 *Obviousness*

21 A claimed invention is unpatentable if the differences between it and the
22 prior art are “such that the subject matter as a whole would have been obvious at
23 the time the invention was made to a person having ordinary skill in the art.” 35
24 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-30
25 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

1 In *Graham*, the Court held that that the obviousness analysis is bottomed on
2 several basic factual inquiries: “[(1)] the scope and content of the prior art are to be
3 determined; [(2)] differences between the prior art and the claims at issue are to be
4 ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383
5 U.S. at 17. *See also KSR Int’l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The
6 combination of familiar elements according to known methods is likely to be
7 obvious when it does no more than yield predictable results.” *KSR*, at 1739.

8 “When a work is available in one field of endeavor, design incentives and
9 other market forces can prompt variations of it, either in the same field or a
10 different one. If a person of ordinary skill can implement a predictable variation, §
11 103 likely bars its patentability.” *Id.* at 1740.

12 “For the same reason, if a technique has been used to improve one device,
13 and a person of ordinary skill in the art would recognize that it would improve
14 similar devices in the same way, using the technique is obvious unless its actual
15 application is beyond his or her skill.” *Id.*

16 “Under the correct analysis, any need or problem known in the field of
17 endeavor at the time of invention and addressed by the patent can provide a reason
18 for combining the elements in the manner claimed.” *Id.* at 1742.

19 ANALYSIS

20 *Claims 1-4 and 7-24 rejected under 35 U.S.C. § 103(a) as unpatentable over*
21 *Christiano.*

22 The Examiner found that Christiano described determining whether a user has
23 a valid software license to run a software application including sending a query to
24 the license management system and permitting a recognized user to execute said

1 software application in the event of inaccessibility of the license management
2 system. The Examiner further found that Christiano contemplates license
3 inaccessibility due specifically to failure of the license management system. The
4 Examiner concluded that it would be obvious to one of ordinary skill in the art at
5 the time the invention was made to expand license inaccessibility in such a way as
6 to include not only actual failure of the license management system but also
7 failures in communication (Answer 4).

8 The Appellants contend that Christiano does not describe a recognized user
9 (Appeal Br. 5-6). The Examiner replies that Christiano describes that "licenses are
10 typically denied to new requesters". The Examiner inferred that if licenses are
11 being denied to new requestors, the same licenses are being granted to old
12 requestors, more commonly known as recognized users (Answer 13).

13 We agree with the Appellants. A recognized user is a user who has been
14 previously authorized by the license management system as a valid user (FF 01).
15 The passage cited by the Examiner refers to new requesters, not new users. The
16 passage pertains to the state in which no new licenses would be available (FF 03),
17 not a state of recognizing new versus old users.

18 The Examiner presents no finding that Christiano has the capability to
19 recognize a user who has been previously authorized by the license management
20 system as a valid user. We find no such description in Christiano (FF 04). Further,
21 as the Appellants contend, Christiano depends on communication with the license
22 database to access its fail safe indicator (Reply Br. 2-3; FF 03). Therefore,
23 Christiano fails to permit a recognized user to execute an application if the license
24 management system is unable to receive a query regarding a user.

CONCLUSIONS OF LAW

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-4 and 7-24 under 35 U.S.C. § 103(a) as unpatentable over Christiano.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-4 and 7-24 under 35 U.S.C. § 103(a) as unpatentable over Christiano is not sustained.

REVERSED

Appeal 2008-3066
Application 09/982,852

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